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Name: <u>Feng Mizondo</u>	<u>12/11/2006</u>
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Petitioner's Docket No. FERN-P001E

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Fernandez, et al.

Application No.: 09/823,508

Art Unit: 2621

Filed: 03/29/2001

Examiner: Vo, Tung T

For: INTEGRATED NETWORK FOR MONITORING REMOTE OBJECTS

**TRANSMITTAL OF APPEAL BRIEF
(PATENT APPLCIATION – 37 C.F.R. § 1.192)**

1. Transmitted herewith, in triplicate, is the APPEAL BRIEF in this application, with respect to the Notice of Appeal filed on 10/11/2006.
2. STATUS OF APPLICANT

This application is on behalf of

☐ other than a small entity

☒ small entity

A statement:

☐ is attached.

☒ was already filed.

3. FEE FOR FILING APPEAL BRIEF

Pursuant to 37 C.F.R. 1.17 (c), the fee for filing the Appeal Brief is:

☒ small entity

\$250.00

☐ other than a small entity

\$500.00

Pursuant to 37 C.F.R. 1.17 (d), the fee for request for Oral Hearing is:

☐ small entity

\$500.00

☐ other than a small entity

\$100.00

Appeal Brief fee due \$ 250.00

4. EXTENSION OF TERM

The proceedings herein are for a patent application and the provisions of 37 C.F.R. §1.136 apply.

(a) ☐ Applicant petitions for an extension of time under 37 C.F.R. §1.136 (fees: 37 C.F.R. § 1.17 (a) (1)-(5)) for the total number of months checked below:

	Extension (months)	Fee for other than <u>small entity</u>	Fee for <u>small entity</u>
<input type="checkbox"/>	one month	\$120.00	\$60.00
<input type="checkbox"/>	two months	\$450.00	\$225.00
<input type="checkbox"/>	three months	\$1,020.00	\$510.00
<input type="checkbox"/>	four months	\$1,590.00	\$795.00
<input type="checkbox"/>	five months	\$2,160.00	\$1080.00

Fee: \$ _____

If an additional extension of time is required, please consider this petition thereof.

☐ An extension for _____ months has already been secured, and the fee paid therefore of \$ _____ is deducted from the total fee due for the total months of extension is now requested.

Extension fee due with this request \$ _____
or

- (b) ☐ Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

5. TOTAL FEE DUE

The total fee due is:

Appeal Brief Fee \$ 250.00

Extension Fee (if any) \$ _____.

6. FEE PAYMENT

☒ Attached is check No. 1730 in the sum of \$ 250.00. However, in case Applicant inadvertently miscalculated any required fee, the Commissioner is hereby authorized to charge the necessary additional amount associated with this communication or credit any overpayment to **Deposit Account No. 500482**. A duplicate copy of this authorization is enclosed.

☐ Charge Account No. **500482** the sum of \$ _____.
A duplicate of this transmittal is attached.

7. FEE DEFICIENCY


☒ If any additional extension and/or fee is required, this is a request therefore and to charge Account No. 500482.

AND/OR

☐ If any additional fee for claims is required, charge
Account No. _____.

Respectfully submitted,

12/11/2006
Date



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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

Inventors: Fernandez, et al.)	Attorney Docket No.: FERN-P001E
)	
Application No. 09/823,508)	Examiner: Vo, Tung T.
)	
Filed: 03/29/2001)	Art Unit: 2621
)	
For: INTEGRATED NETWORK)	
FOR MONITORING)	
REMOTE OBJECTS)	
)	

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APPEAL BRIEF
IN SUPPORT OF APPELLANTS' APPEAL
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants hereby submit the following Appeal Brief pursuant to 37 CFR 41.37 and fee set forth in § 41.20(b)(2), in support of an appeal from the final rejection by the Examiner, dated July 12, 2006 and advisory action dated September 26, 2006, in the above-captioned case.

Appellant filed a notice of appeal under § 41.31 on October 11, 2006. Also, Appellants assert that the following brief does not include any new or non-admitted amendment, affidavit, or other evidence. Appellants respectfully request consideration of this appeal by the Board of Patent Appeals and Interferences for allowance of the above-captioned patent application.

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A. Examiner has not provided a <i>prima facie</i> case of obviousness for the rejection of claims 68, 70 and 72 under 35 U.S.C. 103(a) as being unpatentable over Fan, et al. (US 5,959,577) in view of Hollenberg (US 6,091,956).	
B. Examiner has not provided a <i>prima facie</i> case of obviousness for the rejection of claims 69, 71 and 73 under 35 U.S.C. 103(a) as being unpatentable over Fan, et al. (US 5,959,577) in view of Hollenberg (US 6,091,956) as applied to claims 68, 70 and 72 in further view of Kennedy, III, et al. (US 6,301,480).	
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X. <i>Related proceedings appendix</i>	NONE

I. Real party in interest

The real party in interest is Dennis Fernandez, an individual, having a residence at 1175 Osborn Avenue, Atherton, CA 94027.

II. Related appeals and interferences

Related proceedings to this application include US Patent Application No. 09/823,089 with Appeal Brief filed on June 12, 2006 and Application No. 09/823,509 with Appeal Brief filed on October 24, 2006. To the best of Appellant's knowledge, there are no other prior or pending appeals, judicial proceedings or interferences known to the appellant which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

In Examiner's Advisory Action Before the Filing of an Appeal Brief, mailed September 26, 2006, claims 68-73 were **rejected**. Claims 1-67 have been canceled. Claims 68-73 are currently pending in this proceeding, Claims 68, 70 and 72 being independent claims. These pending claims, 68-73, are being appealed, and are appended herewith in the **Claims appendix**.

IV. Status of Amendments

In the Final Office Action mailed July 12, 2006, Examiner rejected claims 68-73. Subsequent to this final rejection, Appellants responded with an amendment filed September 11, 2006. Examiner **entered** the proposed amendments, in the Advisory

Action, while affirming the rejection of claims 68-73. All pending claims 68-73 on appeal are provided in the **Claims appendix**, as filed in the September 11 amendment.

V. Summary of claimed subject matter

Claims 68, 70 and 72 are independent claims pending in this Appeal. The subject matter defined in each of these independent claims is related remote surveillance and communications technology, particularly to integrated fixed and mobile network electronics and related software for object attribute processing (see Appellants' Specification page 1, lines 7-9).

Specifically, in a network for coupling at least one fixed vendor processor to at least one mobile buyer processor a method, vendor processor, or mobile buyer processor for transacting between vendor and buyer processors, with one or more buyer processors, or with one or more fixed vendor processors respectively (page 9, lines 9-page 10, line 5; page 6, lines 7-14; page 25, lines 13-18; and page 27, lines 1-7); the method comprising steps of: determining a first location of a mobile buyer processor coupled to a network; the vendor processor comprising: a processor and a storage, wherein provided at least in part in the storage for execution by the processor is software for determining a first location of a mobile buyer processor coupled to the Internet; or the mobile buyer processor comprising: a processor and a storage, wherein provided at least in part in the storage for execution by the processor is software for indicating a first location of such mobile buyer processor (page 9, lines 1-7; page 9, line 29-page 10, line 5; page 11, lines 9-16; page 11, line 29-page 12, line 6); receiving from the mobile buyer processor a first transaction message; or a first transaction message being receivable or transmittable to a

vendor processor by the mobile buyer processor; and sending to a the mobile buyer processor a second transaction message or the vendor processor accordingly sending to the mobile buyer processor a second transaction message (page 24, line 14-page 25, line 28; and page 27, lines 1-7).

Such message indicating a first fixed vendor processor proximately disposed to the first location, wherein the second transaction message is caused to be sent adaptively by software that matches a mobile buyer interest with a fixed vendor service or product by using past movement or location pattern of the mobile buyer, thereby facilitating local transaction efficiently between the mobile buyer and a nearby vendor (page 24, line 30-page 25, line 11), the second transaction message indicating real-time inventory and location-based pricing of service or product of interest to the mobile buyer available at the nearby vendor (page 23, line 25-page 24, line 5; and page 24, lines 14-19), the software providing access by the vendor processor to a video surveillance of the mobile buyer, thereby automatically enabling such video surveillance of the mobile buyer to be performed automatically by the software having adaptive personal-image visual recognition ability automatically to provide computer-implemented visual recognition indication of a personal image of such mobile buyer (page 28, lines 4-15; page 29 line 17-page 30, line 13; and page 33, lines 1-15), the software being partitioned modularly (page 14, lines 11-22) or layered hierarchically in a first core component comprising a database (page 15, lines 6-25), and a next functional component comprising a transaction module (page 23, line 25-page 25, line 28), whereby one or more software agent functions cooperatively with or uses the first core or next functional component to enable

extended or integrated network transaction between vendor and buyer processors (page 25, lines 13-18).

VI. Grounds of rejection to be reviewed on appeal

- A. Whether claims 68, 70 and 72 are unpatentable under 35 U.S.C. 103(a) over Fan, et al. (US 5,959,577) in view of Hollenberg (US 6,091,956).
- B. Whether claims 69, 71 and 73 are unpatentable under 35 U.S.C. 103(a) over Fan, et al. (US 5,959,577) in view of Hollenberg (US 6,091,956) as applied to claims 68, 70 and 72, and in further view of Kennedy, III, et al. (6,301,480).

VII. Argument

- A. **Examiner has not provided a *prima facie* case of obviousness for the rejection of claims 68, 70 and 72 under 35 U.S.C. 103(a) as being unpatentable over Fan, et al. (US 5,959,577) in view of Hollenberg (US 6,091,956).**

Appellants respectfully traverse the rejection under §103(a) and submit that Examiner fails to satisfy the burden of proving *prima facie* obviousness. The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. MPEP 706.02(j). That burden has not been met here without a sufficient showing of some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *In re Kotzab*, 216 F.3d 1365, 1369, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 986 78 USPQ2d 1329, 1335 (Fed. Cir. 2006). The Court has discussed the importance of relying on objective evidence and making specific factual findings to the

motivation to combine references. See *In re Lee*, 277 F.3D 1338, 1342-44, 61 USPQ2D 1430, 1433-34 (Fed. Cir. 2002).

The factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority ... The Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion. *Id.* at 1343-44.

Therefore, the *Lee* Court suggests that the Examiner must provide objective evidence of fact in determining whether to combine references.

There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). In falsely attempting to prove motivation to combine Fan and Hollenberg, Examiner has speculated that such combination would solve the nature of the problem as discussed by Hollenberg:

update the location based pricing of service and able view or observe the image of the person of mobile buyer. Doing so would allow many stores are cutting costs by reducing staffing and merchandise inventories. Shoppers searching for price or stock information in a store must now spend more time searching the isles for held in finding the merchandise they seek. Clearly, useful time-critical and specific information about the stores' offerings, merchandise information, is increasingly out of reach.

Here, Examiner cites Hollenberg in suggesting that the invention disclosed in patent 6,091,956 can satisfy people's need for information that specifically fits their needs, such as price and stock information in a store and that such information can save time. Rather, Appellants' invention solves a rather different problem. The problem addressed by Appellants' invention pertains to adaptively transmitting between the mobile buyer and nearby vendor, transaction messages indicating real-time inventory, etc. *and* software

providing access by the vendor processor to a video surveillance of the mobile buyer, with such software having adaptive personal-image recognition ability automatically to provide computer-implemented visual recognition indication of a personal image of such mobile buyer. The unique implementation of *visual recognition* capability in the setting of buyer and vendor communication of Appellants' invention is neither taught, suggested, or motivated by Fan nor Hollenberg. Such capability is discussed in detail in Appellants Specification on page 28, lines 4-15; page 29 line 17-page 30, line 13; and page 33, lines 1-15.

Examiner has not provided a sound and logical basis in objective fact and reasoning to suggest the combination of Fan and Hollenberg to solve the nature of the problem as addressed by Appellants' invention. Therefore Appellants respectfully traverse the rejection of Claims 68, 70 and 72 under 35 U.S.C. 103(a) as Examiner has not proven a *prima facie* case of obviousness.

B. Examiner has not provided a *prima facie* case of obviousness for the rejection of claims 69, 71 and 73 under 35 U.S.C. 103(a) as being unpatentable over Fan, et al. (US 5,959,577) in view of Hollenberg (US 6,091,956) as applied to claims 68, 70 and 72 in further view of Kennedy, III, et al. (US 6,301,480).

Similarly, in attempting to prove motivation to combine Fan, Hollenberg and Kennedy, Examiner has falsely speculated that this combination would:

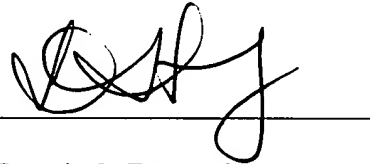
provide the determined information on the status of the mobile unit (car, truck) to the remote location (16 of fig. 1). Doing so would provide the advantages of the system include the adaptation of the system to provide mobile units are associated with cars, trucks, boats, barges, airplanes, cargo holders, persons or other mobile items such as ambulance vehicle that desire a selection of services. These services include emergency services, roadside assistance, information services (e.g., directions, news and weather reports, financial quotes, etc.), or other as suggested by Kennedy.

Here Examiner cites Kennedy as suggesting that the invention disclosed in the 6,301,480 would provide a variety of services in a mobile environment. However, Appellants argue that neither Fan, Hollenberg nor Kennedy motivate one to combine the references to specifically solve the problem of adaptively transmitting between the mobile buyer and nearby vendor, transaction messages indicating real-time inventory, etc. *and* software providing access by the vendor processor to a video surveillance of the mobile buyer, with such software having adaptive personal-image recognition ability automatically to provide computer-implemented visual recognition indication of a personal image of such mobile buyer, to ultimately determine information on the mobile buyer vehicle. Such capability is discussed in detail in Appellant's Specification on page 27, lines 9-27; page 28, lines 4-15; page 29 line 17-page 30, line 13; and page 33, lines 1-15. Therefore, Appellants respectfully traverse the rejection of Claims 69, 71 and 73 under 35 U.S.C. 103(a) as Examiner has not proven a *prima facie* case of obviousness.

CONCLUSION

For all of the reasons stated above, Appellant respectfully concludes that Examiner was in error to reject claims 68, 70 and 72 as being unpatentable over Fan, et al. (US 5,959,577) in view of Hollenberg (US 6,091,956) and claims 69, 71 and 73 as being unpatentable over Fan, et al. (US 5,959,577) in view of Hollenberg (US 6,091,956) as applied to claims 68, 70 and 72, and in further view of Kennedy, III, et al. (6,301,480) under 35 U.S.C. 103(a). Therefore, Appellant prays for careful consideration of this appeal by the Board of Patent Appeals and Interferences in order for the ultimate allowance of all Claims 68-73.

Respectfully Submitted,



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Date: 12/11/2006

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VIII. Claims appendix

Claims Presented For Appeal **(as filed via Rule-116 Amendment dated September 11, 2006)**

Claims 1- 67 (**CANCELED**).

68. (**PREVIOUSLY PRESENTED**) In a network for coupling at least one fixed vendor processor to at least one mobile buyer processor, a method for transacting between vendor and buyer processors, the method comprising the steps of:

determining a first location of a mobile buyer processor coupled to a network;
receiving from the mobile buyer processor a first transaction message; and
sending to the mobile buyer processor a second transaction message indicating a first fixed vendor processor proximately disposed to the first location, wherein the second transaction message is caused to be sent adaptively by software that matches a mobile buyer interest with a fixed vendor service or product by using past movement or location pattern of the mobile buyer, thereby facilitating local transaction efficiently between the mobile buyer and a nearby vendor, the second transaction message indicating real-time inventory and location-based pricing of service or product of interest to the mobile buyer available at the nearby vendor, the software providing access by the vendor processor to a video surveillance of the mobile buyer, thereby automatically enabling such video surveillance of the mobile buyer to be performed automatically by the software having adaptive personal-image visual recognition ability automatically to provide computer-implemented visual recognition indication of a personal image of such mobile buyer, the software being partitioned modularly or layered hierarchically in a first core component comprising a database, and a next functional component comprising a transaction module, whereby one or more software agent functions cooperatively with or uses the

first core or next functional component to enable extended or integrated network transaction between vendor and buyer processors.

69. **(PREVIOUSLY PRESENTED)** The method of claim 68 wherein:

one or more fixed vendor processor receives a signal from a single-chip sensor coupled to a mobile buyer vehicle to determine that the vehicle has a flat tire or airbag deployment, thereby modifying the mobile buyer interest for matching appropriate vendor service or product.

70. **(PREVIOUSLY PRESENTED)** In a network for coupling at least one fixed vendor processor to at least one mobile buyer processor, a vendor processor for transacting with one or more buyer processor, the vendor processor comprising:

a processor and a storage, wherein provided at least in part in the storage for execution by the processor is software for determining a first location of a mobile buyer processor coupled to the Internet, a first transaction message being receivable by the vendor processor from the mobile buyer processor, and the vendor processor accordingly sending to the mobile buyer processor a second transaction message indicating a fixed vendor processor proximately disposed to the first location, wherein the second transaction message is caused to be sent adaptively by software that matches a mobile buyer interest with a fixed vendor service or product by using past movement or location pattern of the mobile buyer, thereby facilitating local transaction efficiently between the mobile buyer and a nearby vendor, the second transaction message indicating real-time inventory and location-based pricing of available service or product of interest to the mobile buyer, the software providing access to a video surveillance of the mobile buyer, thereby automatically enabling such video surveillance of the

mobile buyer to be performed automatically by the software having adaptive personal-image visual recognition ability automatically to provide computer-implemented visual recognition indication of a personal image of such mobile buyer, the software being partitioned modularly or layered hierarchically in a first core component comprising a database, and a next functional component comprising a transaction module, whereby one or more software agent functions cooperatively with or uses the first core or next functional component to enable extended or integrated network transaction between vendor and buyer processors.

71. **(PREVIOUSLY PRESENTED)** The vendor processor of claim 70 wherein:
the processor receives a signal from a single-chip sensor coupled to a mobile buyer vehicle to determine that the vehicle has a flat tire or airbag deployment, thereby modifying the mobile buyer interest for matching appropriate vendor service or product.

72. **(PREVIOUSLY PRESENTED)** In a network for coupling at least one fixed vendor processor to at least one mobile buyer processor, a mobile buyer processor for transacting with one or more fixed vendor processor, the mobile buyer processor comprising:
a processor and a storage, wherein provided at least in part in the storage for execution by the processor is software for indicating a first location of such mobile buyer processor, a first transaction message being transmittable to a vendor processor by the mobile buyer processor, and the vendor processor accordingly sending to the mobile buyer processor a second transaction message indicating a fixed vendor processor proximately disposed to the first location, wherein the second transaction message is caused to be sent adaptively by software that matches a mobile buyer interest with a fixed vendor service or product by using past movement or location pattern

of the mobile buyer, thereby facilitating local transaction efficiently between the mobile buyer and a nearby vendor, the second transaction message indicating real-time inventory and location-based pricing of service or product of interest to the mobile buyer available at the nearby vendor, the software providing access by the vendor processor to a video surveillance of the mobile buyer, thereby automatically enabling such video surveillance of the mobile buyer to be performed automatically by the software having adaptive personal-image visual recognition ability automatically to provide computer-implemented visual recognition indication of a personal image of such mobile buyer, the software being partitioned modularly or layered hierarchically in a first core component comprising a database, and a next functional component comprising a transaction module, whereby one or more software agent functions cooperatively with or uses the first core or next functional component to enable extended or integrated network transaction between vendor and buyer processors.

73. **(PREVIOUSLY PRESENTED)** The mobile buyer processor of claim 72 wherein:
one or more fixed vendor processor receives a signal from a single-chip sensor coupled to a mobile buyer vehicle to determine that the vehicle has a flat tire or airbag deployment, thereby modifying the mobile buyer interest for matching appropriate vendor service or product.

VIII. Evidence appendix

None.

X. Related proceedings appendix

None.